REMARKS

Applicants respectfully request reconsideration of the rejection of claims 3-14 in view of Applicants' Response to Final Rejection dated September 1, 2004 ("Applicants' Response to Final Rejection"), the Declaration submitted herewith and the following remarks.

The Advisory Action maintained the rejection of claims 3-14 under 35 U.S.C. § 103(a) as obvious over Park et al., *Homogenous Proximity Tyrosine Kinase Assays*, Anal. Biochem. 269: 94-104 (1999) ("the Park publication") in view of Applicants' prior sale of cross-linked allophycocyanin which had not been exposed to strongly chaotropic agents ("Applicants' product").

In establishing prima facie obviousness, it is necessary to show that one of ordinary skill in the art having the reference before him be motivated to make the proposed substitution, combination or other modification. *In re Lintner*, 458 F.2d 1013, 173 U.S.P.Q. 560 (C.C.P.A. 1972).

The Final Office Action set forth the argument that one of skill in the art would be motivated to substitute Applicants' product for prior art allophycocyanin used in accordance with the Park publication. *See* Final Office Action, page 5. The Final Office Action stated that Applicants' sale of Applicants' product was motivation for such a substitution because the only possible use for Applicants' product was in an assay in accordance with the Park publication. *See id.*

As stated in Applicants' Response to Final Rejection, Applicants submit that their product was sold for use in a variety of assays other than time-resolved fluorescence assays. In support of Applicants' position, Applicants submitted along with Applicants' Response to Final Rejection nine (9) abstracts of technical references published from 1994-2000 that describe use of allophycocyanin in flow cytometric assays which do not involve time resolved fluorescence. However, the Advisory Action stated that

> Applicant provides nine (9) abstracts of papers . . . which describes the use of allophycocyanin in flow cytometric assays which do not involve time resolved fluorescence. These abstracts are not found persuasive because they are not clear on whether or not the

> allophycocyanin used in the assays is the native form of allophycocyanin or cross-linked allophycocyanin. . . . Applicant has not provided evidence to support the statements there is other known art uses for cross-linked allophycocyanin.

Advisory Action, pages 2-3 (emphasis in original).

Applicants respectfully assert that the Declaration submitted with the present Response clearly demonstrates that the allophycocyanin taught in each of the nine (9) technical references, whose abstracts were submitted with Applicants' Response to Final Rejection, is indeed cross-linked allophycocyanin. Thus, as the Declaration establishes, each of the technical references teaches the use of cross-linked allophycocyanin in standard binding assays such as flow cytometric assays, which do not involve time-resolved fluorescence.

In sum, the Declaration shows that a variety of art-recognized uses for cross-linked allophycocyanin exist that do not involve time-resolved fluorescence. In addition to flow cytometry assays, such uses include histochemistry, blot analysis and immunoassays.

Therefore, given the multitude of art-recognized uses for cross-linked allophycocyanin, it is not inevitable that Applicants' product would have been used in a time-resolved fluorescence assay. Consequently, mere commercial availability of Applicants' product would not motivate the skilled person to use this product in the time-resolved fluorescence method disclosed in the Park publication with any reasonable expectation of achieving the benefits disclosed in the present application. Such benefits include those set forth in Example 8, which begins on page 16, line 23 of the Specification. The Example shows that SL-APC streptavidin conjugate of the invention in TR-FRET for src kinase assay demonstrated an improved sensitivity over commercially available XL-APC streptavidin. Thus, prior to the inventors' unexpected discovery, there was no expectation that the Park publication in combination with Applicants' product would provide an improved assay. Consequently, the present invention is not obvious, and Applicants respectfully request that the rejection of claims 3-14 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing Remarks and Declaration submitted herewith, and in view of Applicants' Response to Final Rejection, Applicants respectfully submit that claims 3-14 of the instant application are in condition for allowance, and such disposition is earnestly solicited. Should the Examiner believe that any patentability issues remain after consideration of this Response, the Examiner is invited to contact the Applicants' undersigned representative to discuss and resolve such issues.

Applicants are submitting herewith an RCE along with the requisite fee of $395.00 (Small Entity). In the event that a variance exists between the amount tendered and that deemed necessary by the U.S. Patent and Trademark Office to enter and consider this Response or to maintain the present application pending, please credit or charge such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: March 1, 2005

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